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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,611	12/17/2001	Yuki Sasaki	I-11482	5891
25944	7590	04/21/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			WELLS, LAUREN Q	
		ART UNIT	PAPER NUMBER	1617

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/015,611	SASAKI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Lauren Q Wells	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 19 December 2003.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

Claims 1-22 are pending. Claims 18-22 are withdrawn from consideration, as they are directed to non-elected subject matter.

### ***Election/Restrictions***

The arguments against the election/restriction requirement are not new and were addressed in the previous Office Action. See the previous Office Action for a response to these arguments. As stated in the previous Office Action, this requirement has been made final.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the machine translation of JP 2001-151639.

The instant invention is directed toward a resin powder.

JP '639 exemplify a resin powder composition comprising polystyrene particles of 4.8 micrometers and titanium oxide (other fine particle). The reference teaches that the particle size distribution, in addition to the actual size of the particle can be adjusted by adjusting the polymerization conditions to achieve specific powder properties for specific composition embodiments, see [0010], [0011], [0004]. The reference does not explicitly state the shape factor, average volume particle size distribution, surfaceness index, volumetric ratio.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shape factor, average volume particle size distribution, surfaceness index, and volumetric ratio of JP '639 to that of the instant claims, because JP '639 teach that it is conventional in the art to modify the size of the particles. Additionally, it would have been an obvious matter of design choice to exemplify powders with an SF1 of 110-140, GSDv of 1.3 or less, volume particle size of 20um or greater as 3% or less, and a surfaceness index of 2 or less, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

It is respectfully pointed out that a compound and its properties are inseparable and that the instant specification teach polystyrene's as resin powders. Thus, the polystyrene of JP '639 must have the chemical properties recited in the instant claims, i.e., glass transition temperature, water content, acid value, volatile content . . .

The Examiner respectfully points out instant claims 12-17 are product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-151639 as applied to claims 1-4, 7-17 above, and further in view of JP 06070702.

JP '639 is applied as discussed above. The reference does not explicitly state the molecular weight of resin.

JP '702 teaches that powders useful in cosmetics have a molecular weight of 500-100,000. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the powder resin of JP '639 as having a molecular weight of between 500 and 100,000 because of the expectation of achieving a powder that is cosmetically acceptable for application to the skin and/or hair. Furthermore, it is respectfully pointed out that the molecular weight of polystyrene molecules is easily altered by manipulating the "n" number of repeating units.

#### ***Response to Arguments and Declaration***

The arguments against the 35 USC 102 rejection in combination with the 132 Declaration are persuasive to overcome the 35 USC 102 rejection in the previous Office Action.

Applicant argues, regarding JP '702, "The powder, however, has a particle size of from 30 to 100um, and thus falls outside the particle size range as claimed". This argument is not persuasive, as JP '702 is merely relied upon to teach preferred molecular weights of cosmetic powders.

#### ***Conclusion***

Applicant's declaration necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SUPERVISORY PATENT EXAMINER